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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/511,780	02/23/2000	Johannes Baensch	8265-305	3549

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EXAMINER

MADSEN, ROBERT A

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/511,780

Applicant(s)

BAENSCH ET AL.

Examiner

Robert Madsen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on January 28, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-30, 32-36 and 38-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-30, 32-36 and 38-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The Amendment filed January 28, 2004 has been entered. Claims 26-30, 32-36, 38-46 are pending.

#### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 26, 28, 30, 32, 33, 35, 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hilhorst, et al. (EP0773722 B1) in view of Schotel (US 5624702) and Gebhardt et al.
4. Regarding claims 26, the amended claim now recites 8-30% of a sugar which *consists essentially of* sucrose, invert sugar syrup, honey or combinations thereof. It is noted that while Hilhorst et al. teach oligofructose, Hilhorst et al. further teach 12% saccharose, which is sucrose (Example 8), and further teaches such products can be used as sweet spreads (Page 4, lines 38-40). The new limitation does not exclude other sugars from being present in the composition, since the preamble of the claim recites "A cream composition *comprising* a mixture of". Therefore, to select a level of 12% sucrose or other than 12% sucrose would have been an obvious matter of choice depending on the degree of sweetness one desired since Hilhorst et al. teach adding 12% saccharose and further teaches sweet spreads.
5. Regarding claims 28, 30, 32, 33, 35 and 46, see the rejections set forth in Office Action mailed September 29, 2003.

6. Claims 26,28-30,32,33,35,46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schotel (US 5624702) evidenced by Gebhardt et al.
7. Regarding claim 26, the amended claim now recites 8-30% of a sugar which *consists essentially of* sucrose, invert sugar syrup, honey or combinations thereof. The new limitation does not exclude other sugars from being present in the composition, since the preamble of the claim recites "A cream composition *comprising* a mixture of". It is noted that Schotel teaches e.g. 0.1-15% sucrose ( Column 2, lines 41-51).
8. Regarding claims 28-30,32,33,35,46, see the rejections set forth in Office Action mailed September 29,2003.
9. Claims 27 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schotel (US 5624702) evidenced by Gebhardt et al. as applied to claims 26,28,30,32,33,35, and 46 above, evidenced by further in view of Tamime et al., Saintain (US 5573793) and Lauro (EP 0666031A2).
10. See the rejections set forth in Office Action mailed September 29,2003.
11. Claims 34,36,39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schotel (US 5624702) evidenced by Gebhardt et al. as applied to claims 26,28,30,32,33,35, and 46 above, further in view of Saintain (US 5573793).
12. See the rejections set forth in Office Action mailed September 29,2003.

13. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schotel (US 5624702) evidenced by Gebhardt et al. as applied to claims 26,28,30,32,33,35, and 46 above, further in view of Saintain (US 5573793) and Kingham et al. (US 4721622).

14. See the rejections set forth in Office Action mailed September 29,2003.

15. Claims 38 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schotel (US 5624702) evidenced by Gebhardt et al.

16. Regarding claim 38, the amended claim now recites 8-30% of a sugar which *consists essentially of* sucrose, invert sugar syrup , honey or combinations thereof, and Schotel teaches e.g. 0.1-15% sucrose ( Column 2, lines 41-51). It is noted that this new limitation also does not exclude other sugars from the composition because the preamble recites "A cream composition *consisting essentially of* a mixture of". "The transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention." In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). Furthermore, "[I]f an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention." In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). Thus since Schotel teaches a cream composition comprising both the 0.1-15% sucrose, as well as other sugars, and teaches the resulting spread is suitable as a flavored spread ,

cheese spread, and sweet spread (Column 4, lines 47-51). Thus, it appears that the added sugars do not materially adversely affect the basic characteristics of a cream composition.

17. Regarding claim 42, see the rejections set forth in Office Action mailed September 29,2003.

18. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schotel (US 5624702) evidenced by Gebhardt et al., as applied to claims 38 and 42 above, further in view of Saintain (US 5573793).

19. See the rejections set forth in Office Action mailed September 29,2003.

### ***Response to Arguments***

20. Applicant's arguments with respect to the rejection of claim 26 made under 35 USC 112, first paragraph and applicant's arguments in light of the amendment with respect to the rejection of claim 35 under 35 USC 112, first paragraph, have been fully considered and are persuasive. The rejections of claims 26 and 35 made under 35 USC 112, first paragraph have been withdrawn.

21. Applicant's arguments filed January 28,2004 with respect to the rejections made under 35 USC 103 (a) have been fully considered but they are not persuasive.

22. Applicant argues that Hilhorst does not teach 8-30% of a sugar which consists essentially of sucrose, invert sugar syrup, honey or combinations thereof as currently recited in claim 26, and applicant believes that claim 26 excludes the presence of the

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oligofructose. As noted above in the rejection of claim 26, Hilhorst teaches adding sucrose at levels of 12%. Furthermore, contrary to applicant's belief, the language of claim 26 does not exclude anything from the composition since applicant states a mixture "comprising" a group of ingredients. The amendment to claim 26, merely limits a composition to comprising *at least* 8-30% of either sucrose, invert sugar syrup, honey or combinations thereof, and does not exclude the composition any other type of sugar.

23. Applicant also argues that although Schotel does teach mono/disaccharides (as noted in the rejection above these include 8-30% sucrose), applicant believes that claims 26 and 38 exclude the presence of the oligofructose. As discussed previously, the amendment to claim 26, merely limits a composition to comprising *at least* 8-30% of either sucrose, invert sugar syrup, honey or combinations thereof, and does not exclude the composition any other type of sugar because the preamble recites a mixture "comprising". As discussed above in the rejection of claim 38, "consisting essentially of" in the preamble of a composition claim does not exclude any other additional ingredients that would affect "the basic and novel characteristic(s)" of the claimed invention". Applicant believes that oligofructose would impart an adverse texture and or taste to the presently recited invention, and by teaching oligofructose, Schotel somehow teaches away from the recited invention. However, it is noted that even with the oligofructose, Schotel teaches that these spreads are suitable as flavored spreads, cheese spreads, and sweet spreads (Column 4, lines 47-51), and the addition of the oligofructose would not affect "the basic and novel characteristic(s)" of the claimed invention".

24. Applicant also states that Hilhorst, although teaching a flavoring agent, does not suggest the "aromatic products". Applicant asserts that since the specification has stated the aromatic products include honey, cocoa, coffee, caramel, hazelnuts, almonds, vanilla, fruit syrup, concentrated fruit juices, or combinations thereof, and the "flavoring agents" of Hilhorst do not include such products. However, the examiner asserts that flavors are aromatic compounds, and that the particular aromatic products are not recited in the independent claim.

25. Applicant asserts that the water continuous spreads taught by both Schotel and Hilhorst would not have the recited water activity values recited in the claims. However, both Schotel and Hilhorst teach aqueous spread compositions that include the broadly claimed compositions recited in claims 26 and 38 ( only differing by the specific dairy protein source), and follow the same procedure as disclosed by applicant to prepare the compositions(i.e. pasteurizing, and cooling to a homogeneous mixture to 10°C (See Hilhorst, Page 4, lines 45-50, and Schotel Column 4, lines 53-62). Thus the compositions would appear to have the same water activity values.

26. With respect to the rejection of claims 27 and 44, applicant's argues that the examiner has combined an excessive number of references. However, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). However, Schotel teach yogurt, Tamime et al. teaches the conventional yogurt properties, while the other two references teach the desirability of maintaining live cultures in fermented dairy products .



27. Applicant further insists that the examiner's conclusion of obviousness is based upon improper hindsight reasoning. However it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicant argues that one of ordinary skill in the art would not have combined Kingham and Saintain, with Schotel, because the products are different. The examiner presents these references as evidence of conventional mercantile packaging of yogurt containing spread compositions, as taught by Schotel.

### ***Conclusion***

28. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Madsen whose telephone number is (571) 272-1402. The examiner can normally be reached on 7:00AM-3:30PM M-F.

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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Art Unit 1761

